

REMARKS

Claims 1, 5, 6, 7, 8, 9, 14, and 15 are amended, Claim 2 is canceled without prejudice, and new Claims 22-33 are added to claim the invention in alternative language.

Claims 1 and 3-33 remain for consideration. All claims are thought to be allowable over the cited art.

Rejection of Claims 1, 3-6, and 9-10 Under 35 USC §102(b)

The Office Action does not show that Claims 1, 3-6, and 9-10 are anticipated by U.S. Patent No. 5,708,773 to Jeppesen, III et al. ("Jeppesen") under 35 USC §102(b). The rejection is respectfully traversed because the Office Action fails to show that all the limitations of the claims are taught by Jeppesen.

For example, Claim 1 includes limitations of a second controller and a second shift register being implemented in programmable logic of the PLD, as well as other related limitations. These limitations are clearly neither shown nor suggested by Jeppesen. Thus, the Office Action does not show that Claim 1 is anticipated. Claims 3-6 are allowable over Jeppesen for at least the reasons of Claim 1, from which they depend.

Claims 9-10 are likewise not shown to be anticipated by Jeppesen. Jeppesen does not address programmable logic devices, and therefore clearly neither teaches nor suggests "programming the programmable logic device having the boundary scan structure to implement a shift register and a controller..." as claimed in Claim 9. Therefore, Claim 9 is allowable over Jeppeson. Claim 10 is allowable over Jeppeson for at least the reasons of Claim 9, from which it depends.

Rejection of Claims 1-21 Under 35 USC §102(e)

The Office Action does not establish that Claims 1-21 are anticipated 35 under USC §102(e) by U.S. patent 6,757,844 to Lulla et al. (hereinafter, "Lulla"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations of the claims are taught by Lulla.

As set forth above, Claim 1 includes limitations of a second controller and a second shift register being implemented in programmable logic of the PLD, as well as other related limitations. These limitations are not taught by Lulla's col. 2, ll. 60-67 as suggested by the Office Action. This section of Lulla simply states that a circuit with JTAG support may be a programmable logic device (PLD). There is no apparent indication that either a controller or shift register are implemented programmable logic resources of the PLD for interfacing with a non-JTAG device. Thus, Claim 1 is not shown to be anticipated by Lulla. Independent method Claims 9 and 14 include limitations of programming programmable logic resources of the PLD to implement the controller and shift register. Thus, Claims 9 and 14 are not shown to be anticipated by Lulla.

The dependent claims are not shown to be anticipated for at least the reasons set forth above for the independent claims.

Rejection of Claim 7 Under 35 USC §103(a)

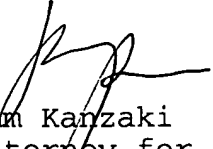
The Office Action does not establish that Claim 7 is obvious under 35 USC §103(a) over Jeppesen in view of U.S. Patent No. 6,324,096 to Tomita ("Tomita"). The rejection is respectfully traversed because the Office Action does not establish a *prima facie* case of obviousness. That is, the Office Action does not show that all the limitations are suggested by the references, does not to provide a proper motivation for modifying the teachings of Jeppesen with teachings of Tomita, and does not show that the combination could be made with a reasonable likelihood of success. However, the rejection is now moot in view of the amendments made to the claims.

CONCLUSION

No new matter is added by the above amendments to the claims.

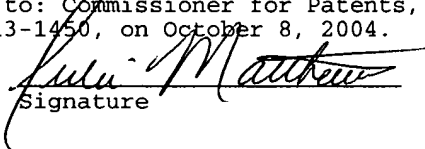
The Office Action fails to establish that the pending claims are anticipated and/or unpatentable in view of the cited references. Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on October 8, 2004.

Julie Matthews  
Name

  
Signature